

REMARKS

Reconsideration of the pending application is respectfully requested in view of the amendments above and the following remarks.

Status of the Application

Claims 1-64 are pending. Claims 1-64 are amended to sharpen the claim language, and provide a description of the subject matter which Applicants consider to be their invention. As the amended claims are fully supported by the application as filed, no new matter has been added to the application by way of these amendments.

In order to advance prosecution, claims 65-67 are canceled without prejudice. Applicants reserve the right to pursue claims 65-67 in this or a subsequent application.

Summary of the Office Action

Claims 1-17, 28-41, and 52-54 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-47 of copending U.S. Patent Application No. 10/434,776.

Claims 1 and 5-64 are further rejected under 35 U.S.C. § 102(b) as allegedly unpatentable over U.S. Patent 6,399,087 ("Zhang et al.").

Discussion

With regard to the obviousness-type double patenting rejection, Applicants may file a terminal disclaimer addressing this rejection upon receipt of an indication of allowable subject matter.

With regard to the rejection under 35 U.S.C. § 102(b), Applicants respectfully traverse the anticipation rejection.

The Office Action alleges that Zhang et al. teaches compositions containing propofol with the other ingredients and in concentration ranges claimed in the current application.

However, the Office Action fails to allege that Zhang et al. discloses the use of any container for its compositions, let alone use of a container which comprises a closure that is inert to propofol. Indeed, it would be improper to do so because Zhang et al. provides no such disclosure or teaching. Moreover, Zhang et al. fails to recognize that placing the claimed propofol formulations in the claimed container (and closure) provides enhanced

degradation-resistance. *See, e.g., pages 29-34 of the application as filed.* Thus, as the claims describe subject matter which is not disclosed or taught by Zhang et al., Applicants respectfully submit that the pending claims are patentable over the cited prior art.

In an effort to overcome the fatal deficiencies of Zhang et al., the Office Action alleges that “how the propofol is stored is not relevant to the instant invention.” *See Final Office Action, page 5.* The Office Action also contends that the “wherein” clauses should be given no weight because the container does not modify the pharmaceutical compositions, and that the limitations requiring that the containers have an inert closure also should be afforded “no patentable weight.” As Applicants have introduced in to the body of the claims a recitation of, *inter alia*, a container which includes a closure which is inert to propofol, it is respectfully submitted that the foregoing arguments are rendered moot. Each claim limitation, regardless of whether it is in a wherein clause, provides a condition that is material to patentability and may not be ignored. *See, e.g., Hoffer v. Microsoft Corp.*, 405 F.3d at 1329; *Griffin v. Bertina*, 285 F.3d at 1033.

In view of the foregoing, the cited prior art fails to disclose or teach the claimed subject matter. Withdrawal of the anticipation rejection over Zhang et al. is, therefore, respectfully requested.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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